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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/755,541

Applicant(s)

ROTHSCHILD, ANTHONY R.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

This action is responsive to the paper(s) filed 10/11/06.

The declaration filed on 12/27/04 under 37 CFR 1.131 has been re-considered but is ineffective to overcome the rejections relying on the Stanbach, Jr. et al (US6449657) and Camut et al (US6684257) references.

The evidence submitted is insufficient to establish conception of the invention prior to the effective date of the references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

- Applicant presents "Cyber Lab's Detailed Proposal" (Appendix D) as providing facts showing conception prior to August 6, 1999, yet the document is merely dated "August 1999," therefore leaving questions as to whether it predates the Stanbach reference (8/6/1999). If the document pre-dates the references in question, then it can be used to provide evidence of conception for the subject matter therein. If the Cyber Lab Detailed Proposal (Exhibit D) is after the critical date of 8/6/1999, it cannot be used to demonstrate diligence because it appears to be evidence of commercial exploitation rather than diligence towards a constructive reduction to practice. Applicant does not

appear to argue that the invention was actually reduced to practice, but rather constructive reduction to practice by way of filing the US Provisional Patent Application.

Also, the following are not supported by the conception evidence and therefore claiming these features enables the Examiner to apply the references in question as prior art:

- The sender or receiver is compensated with a free service for the advertising. While points and bonuses are supported, there is no clear evidence of a “free service” or what it might be. Further, while a term “FreeMail” was used in Exhibit D, it is unclear what was “free” and whether any free service was provided as compensation for the presence of advertising.
- The ad is selected based on the content of the communication data (the email message content).
- The ad is selected based on the subject matter of the communication data (the email message content).
- The ad is selected based on communication data (which is not believed to include the recipient). See claim 92 for example.
- The ad is chosen based on user-provided “ad-type” preferences.
- While email messages are supported, support for the personal communications to be chat, IM, SMS, video or voice messages cannot be found.

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- The declaration fails to present facts regarding the determination of a particular device's required format and the subsequent formatting of the additional communication data consistent with the formatting requirements.

Because support for these features cannot be found in the conception evidence, the claims which include any of these features can be rejected with the references in question.

Applicant is reminded that: The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of **37 CFR 1.131(b)**. *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

"In determining the sufficiency of a **37 CFR 1.131** affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is

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clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).” MPEP 715.07(a).

“[I]t is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.” MPEP 715.07(a).

While the Examiner is not ruling at this time on the sufficiency of the showing of diligence, Examiner points out that paragraph 12 of the declaration appears to provide allegations rather than facts.

Applicant states that the three previously applied references (Stanbach, Joo and Camut) are not prior art and therefore cannot serve as a basis for a prior art rejection. Examiner points out that a successful swearing behind removes the *rejection of the presented claims*, not the reference altogether. “It should be kept in mind that it is the rejection that is withdrawn and not the reference [MPEP 715 (b)]. “[T]he inventor...may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference” [37 CFR 1.131 (a)].

Therefore when applicant presents a claim limitation not supported by the conception evidence, the references may be used because the “date” for the claim would be the earliest disclosure date (the date of the provisional if supported therein, or the date of the non-provisional if supported therein) where full claim support was ultimately disclosed.

If applicant presents an independent claim which is indeed fully supported by the conception evidence (coupled with proper diligence), the three references may not be used as prior art against that claim. However a claim that depends from said independent claim, but which introduces a claim limitation not supported by the conception evidence, then such a dependent claim can be rejected with the references as prior art to that claim. Applicant's assertion that all independent claims have been successfully sworn behind does not automatically remove the references as applicable prior art against the dependant claims as applicant seems to imply.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 66 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- Claim 66 – Examiner has previously rejection the claim under 112 ¶1 for lacking enablement for the web host formatting the personal communication (i.e. original email) pursuant to the recipient device's formatting requirements. Applicant has responded by referring to figure 7 and apparently *page 18 line 18 to page 19 line 4 and page 20 line 24 to page 21 line 17*. Yet figure 7 and

pages 20-21 of the specification describe the interaction with an already-delivered personal communication, not how the personal communication and its included advertisement are originally formatted specific to the receiver's device. Page 18 refers to a reformatting of the personal communication (original email) for the receiver's device, yet this is accomplished by the *receiver's email server*, not the web host that provides the advertising application in base claim 1. Figure 2 of the disclosure shows the receiver's email server as separate from the web host providing the advertising application. While applicant points to a portion of the specification that appears to address this claim language, the description and claim is not enabled. An email delivery system cannot know what type of device the recipient will use to access the email. It could be accessed with POP3, IMAP, a webmail client, an HTML-compliant client, a text-only client, PDA, cell phone, etc. It is not clear how one of ordinary skill can accomplish what applicant discloses in the spec and claimed in claim 66.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 73 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 73, it is unclear how a step of sending can comprise a step of receiving.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 62-66, 68-70, 72-76, 79-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al (US6449657) in view of Andrews (Andrews, Whit, "Panning for Gold in Technology Stocks," Omaha World-Herald, 01/25/1998, pg 55.R)

Regarding claims 68, 69, 72, 75, 76, 81, 82, Stanbach teaches an email server which includes an application to select one of plural stored advertisements and inserts the advertisement (attaches or embeds) into a personal communication message (internet email) composed by a sender to a specified recipient [col 9]. Stanbach does not appear to compensate the participants for the presence of the advertising. Andrews however teaches that Hotmail provided users with free email accounts in exchange for allowing them to include advertising in each email. This was quite a popular "viral marketing" effort and it would have been obvious to have provided the email services of Stanbach for free in exchange for including viral marketing (user to user) advertisements in the delivered emails.

Regarding claims 62-65, 74, 79, 80, 83-87, 89-92, 94, 95, the advertisements are selected automatically by the server application according to the content of the

message (keywords are taken to be subject matter) or according to known characteristics of the participants. The automated insertion of advertising into an email is taken to provide creation of an advertisement-enhanced email which is in essence an advertisement. Therefore Stanbach's server is taken to create advertisements based upon content and subject matter.

Regarding claims 66, 78, Stanbach teaches that the server can format the message in a format suitable for the recipient because the server is made aware of the recipient's requirements [col 14 lines 31-39].

Regarding claims 70, 73, Stanbach teaches that the ads may include URLs or HTML inserted into the message body and may link the recipient to more information upon activation/interactions [14:43-47].

Regarding claim 88, 93, Stanbach teaches that the participant can access and edit his profile which is the basis for ad selection. The user may specify the advertisements to be used – this step is taken to read on submission of ad-type data. Further, the user-specified message content determines the ads and therefore the message content (such as keywords) can read on submission of ad-type data. Further, Stanbach teaches that the participants can specify the types of ads that are suitable for insertion [16:26-30].

Claims 67, 71, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al (US6449657) in view of Andrews and Camut et al (US6684257).

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Regarding claims 67, 71, Stanbach teaches that the ads may include URLs or HTML inserted into the message body and may link the recipient to more information upon activation/interactions [14:43-47]. Camut et al teaches that it is well known for requesting browser clients to have special data format needs and to identify the requesting browser/client/hardware, transcode the requested data into a preferable format and deliver it to the requesting client for rendering [2:28-43, 3:1-30]. It would have been obvious to have provided the additional requested data in a suitable format for compatibility purposes so that PDA, cell phone, PC, MAC recipients can operatively interact with the emails.

Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al (US6449657) in view of Andrews and Goldhaber (US5855008).

Regarding claim 77, Goldhaber teaches the concept of compensating a user who views advertising. It would have been obvious to have compensated the recipient's of Stanbach's emails so that they associate a positive experience with having to view advertising.

Response to Arguments

Applicant argues that the previously applied references cannot be used as prior art. Examiner disagrees for the reasons set forth above.

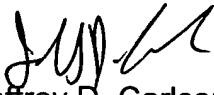
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc